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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,601	04/06/2001	Steven L. Eikenberg	USAM117030	5690

27370 7590 03/04/2004

OFFICE OF THE STAFF JUDGE ADVOCATE  
U.S. ARMY MEDICAL RESEARCH AND MATERIEL COMMAND  
ATTN: MCMR-JA (MS. ELIZABETH ARWINE)  
504 SCOTT STREET  
FORT DETRICK, MD 21702-5012

EXAMINER

BUMGARNER, MELBA N

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 03/04/2004

23

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/828,601

Applicant(s)

EIKENBERG, STEVEN L.

Examiner

Melba Bumgarner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 and 06 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the photographs of the claimed invention are capable of illustration by other medium such as ink drawings, see 37 CFR 1.84(b). Furthermore, the photographs are insufficient in quality that the details of the claimed structure are difficult to discern and would not be reproducible in the printed patent. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. When preparing new drawings in compliance with the requirement therefor, care must be exercised to avoid introduction of anything which could be construed to be new matter prohibited by 35 U.S.C. 132 and 37 CFR 1.121.

### ***Specification***

2. The amendment filed December 22, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure is as follows: It is not clear that the new features as described in the new paragraph to the specification are disclosed in the provisional application. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-10 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. It is not clear from the provisional application that the waste container is a feature of the claimed invention, and as labeled on the correction to figures 1A and 4A and as described in the new paragraph to the specification.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6, 7, 10, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman in view of Bailey et al. Seidman discloses a portable dental treatment system comprising at least one dental bracket table 1, at least one portable base unit 6 including the mechanisms needed to start up dental instruments inside, and at least one suspension device 7,8 couplable between the at least one dental bracket table and the at least one portable base unit; however, Seidman does not show the mechanism being at least one suction pump and a waste container. Bailey et al. teaches a portable dental treatment system comprising a portable base unit including a suction pump 70 and waste container 71. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Seidman to include the suction pump and waste container. One would be motivated to make such

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a modification to provide suction to conventional dental suction instruments for removing waste during dental treatment and to provide a receptacle for the waste. As to claim 2, Seidman shows the at least one table comprising a dental hand piece holder. As to claim 3, Bailey et al. teaches the base unit comprising an air compressor 33. It would have been obvious to modify the system of Seidman to include air compressor to directly provide compressed air to various hand pieces or to pressurize a reservoir of fluid used in dental treatment as taught by Bailey et al. As to claim 4, Seidman and Bailey et al. show the at least one unit comprises an enclosure. As to claim 6, the at least one device comprises a first member 7 operably coupled with a side of the at least one unit and a second member 8 at least partially transverse to the first member, the second member having a first end 11 operably coupled with the at least one table and a second end 13 operably coupled with the first member. As to claim 7, the first member is rotatably attached to the side. As to claim 10, the second member is rotatably attached to the at least one table. As to claims 18-21, Seidman show the method of assembling a portable dental treatment system of above, the device structured to allow a dental patient chair to be positioned substantially below the table.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman in view of Bailey et al. and further in view of Hoffmeister et al. The modified system of Seidman and Bailey et al. shows the limitations as described above; however, they do not show the suspension device comprising a curved member. Hoffmeister et al. teach a dental treatment system comprising at least one device having a curved member 54. It is held to be an obvious matter of choice to one of ordinary skill in the art as to the shape of the member as in Hoffmeister et al. to serve as a suspension device for the table. The specific shape of the member is not critical to the claimed invention, since the applicant contemplates other configurations.

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8. Claim 8 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Seidman in view of Bailey et al. and further in view of Jones. The modified system of Seidman and Bailey et al. shows the limitations as described above; however, they do not show a mounting bracket. Jones teaches a dental system comprising a mounting bracket affixed to the side of the unit and having a circular opening (figure 2) and the first member insertable in the opening. It would have been obvious to one having ordinary skill in the art to further modify the system to have the mounting bracket of Jones to have the suspension device secured to the unit.

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman in view of Bailey et al. and further in view of Beier et al. The modified system of Seidman and Bailey et al. shows the limitations as described above; however, they do not show the second member integrally molded with the first member. Beier et al. teach a dental treatment system comprising the suspension device (first and second members) integrally molded 8. It would have been obvious to one having ordinary skill in the art to further modify the system to have the members of Beier et al. to form a device in one piece for ease of manufacturing and assembly.

### ***Response to Arguments***

10. Applicant's arguments filed December 22, 2003 have been fully considered but they are not persuasive. The provisional application does not sufficiently support applicant's claim that the additional features are present in the claimed invention. These features in the figures (photographs) are not shown in the provisional application. None of the provisional drawings or photographs shows these features, see pages E50 and E51 in particular, nor does the written portion describe the content of the new paragraph. The prior art dental treatment system is portable in that it is shown to be "capable of being carried *or* moved about" (Merriam-Webster's Collegiate Dictionary). Use of the phrase "portable dental treatment system" does not mean

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“designed such that the system can be compacted and bundled so that a relatively fit person can physically carry the portable dental system”. The examiner interprets the limitations in the claims in their broadest sense. Definitions and/or limitations appearing in the specification but not recited in the claim are not read into the claim. Bailey et al. is used to teach the features of the components of the system, not over-the-patient mode.

### *Conclusion*

11. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 703-305-0740.

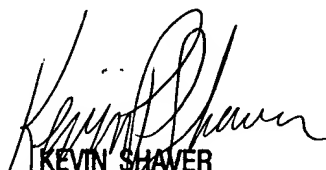
The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Melba Bumgarner  
Patent Examiner



KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700